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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,167	01/28/2004	Takeshi Koyama	396.43422X00	2127
20457	7590	06/22/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			GORR, RACHEL P	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,167

Applicant(s)

KOYAMA ET AL.

Examiner

Rachel F. Gorr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,9,11,13 and 15 is/are rejected.
- 7) ☒ Claim(s) 8,12,14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-27-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant's election with traverse of claims 7-9 and 11-16 in the reply filed on 5-16-05 is acknowledged. The traversal is on the ground(s) that the examiner didn't set forth claims 2 and 3 as process claims; the examiner didn't show that the products of claims 1 and 4-6 and 10 can be used for something other than powder coatings, and that searching all the claims isn't an extra burden. This is not found persuasive because: The examiner acknowledges that claims 2 and 3 are process claims but would search them together with claim one. The reference to Goldstein (5,315,004) shows uretdione products of hydrogenated xylene diisocyanate (col. 7, line 55) and he teaches that (col. 1, lines 13-24) these products can be used for coatings, paints and films and doesn't mention a limited use in powder coatings or prepolymers. The examiner maintains that searching the other inventions of the claims is an extra burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 9 is objected to because of the following informalities: The word urethodione is misspelled. The correct spelling is uretidione, or many patents shorten it to uretdione. This error also occurs in the disclosure. Appropriate correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 9, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laas (066) in view of Hamatsu (Japanese reference).

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5. Laas discloses, in example 1, reacting a diisocyanate uretidione dimer with a mixture of diols and mono-ols at an NCO/OH ratio of 1/1. The ratio of the hydroxyl groups from the diols to those from the mono-ol overlaps that of the claims. In example 6, he combines this product with a polyester polyol to make a powder coating. He differs from the claims by not disclosing hydrogenated xylene diisocyanate among his list of suitable starting diisocyanates (col. 3, lines 24-39).

6. Hamatsu discloses that hydrogenated xylene diisocyanate (page 3, line 12) can be used equivalently for powdered uretdione coatings as the diisocyanates listed by Laas.

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use uretidione of xylene diisocyanate in the invention of Laas because Hamatsu shows it can be used as well as isophorone diisocyanate (IPDI). While the applicants show poorer Erickson values in Table 3-1 with the use of IPDI, Laas shows better Erickson values in col. 11 using IPDI than is shown for the examples in Table 3-1 of the disclosure.

8. Claims 8, 12, 14 and 16 are objected to for depending on rejected claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 571-272-1072. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.G.
June 14, 2005


RACHEL GORR
PRIMARY EXAMINER